

REMARKS

Claims 1-27 are pending in this application. Non-elected claims 8-16 are withdrawn from consideration by the Examiner. By this Amendment, claims 1, 2, 4, 17-20 and 22 are amended, and claims 23-27 are added. Support for the amendments to the claims may be found, for example, in the original claims and in the specification at page 5, line 11 to page 6, line 4. No new matter is added.

I. Election of Species

Applicants respectfully submit that the Office Action improperly maintains the election of species requirement on the grounds that each biomimetic peptides would require a different search. Although this may be sufficient basis for maintaining a restriction or election requirement for non-PCT U.S. patent applications, such a basis is never sufficient to make or maintain such a requirement in PCT National Phase applications.

The Office Action fails to establish a *prima facie* case that there is a lack of unity of invention among the claimed biomimetic peptides. PCT Rule 13.2 governs the situation involving a single claim that defines alternatives, or so-called "Markush practice." As previously argued by Applicants, in order to properly require a restriction between members of a Markush group of biomimetic peptides, the Office Action must show that the biomimetic peptides do not share a common property or a significant structural element that is essential to the common property. *See, e.g.*, ISPE 10.52; MPEP §1850(III)(B). The Office Action fails to demonstrate that the biomimetic peptides do not share a common property or a significant structural element that is essential to the common property and, thus, fails to demonstrate a lack of unity of invention among the recited biomimetic peptides. Therefore, the Election of Species Requirement is clearly improper.

Reconsideration and withdrawal of the Election of Species Requirement are respectfully requested.

II. Rejection Under 35 U.S.C. §112, Second Paragraph

The Office Action rejects claims 1, 17, 18 and 20 as being indefinite under 35 U.S.C. §112, second paragraph.

By this Amendment, claims 1, 17 and 18 are amended to remove the language "for example," rendering their rejections moot.

Without conceding the propriety of the rejection, claim 20 is amended to further recite "a mimicry of an α -MSH, a mimicry of an α -MSH antagonist, a substance P antagonist, a CGRP peptide antagonist, or a bradykinin antagonist." The specification on page 5, line 11 to page 6, line 4 discloses several active principles and provides that the bioactive system selected in the cosmetic composition potentiates one or more of these active principles present in the composition.

Accordingly, reconsideration and withdrawal of the rejections are respectfully requested.

III. Rejection Under 35 U.S.C. §103

The Office Action rejects claims 1-7 and 17-22 under 35 U.S.C. §103(a) over U.S. Patent No. 4,844,884 to Tur (herein "Tur") in view of U.S. Patent No. 5,723,482 to Degwert et al. (herein "Degwert"). Applicants respectfully traverse the rejection.

Claim 1 is directed to a cosmetic composition comprising a bioactive system having a stable and aqueous form of ATP with an optional ATP precursor and "at least one biomimetic peptide comprising at most six amino acids, that mimics a cutaneous polypeptide or a cutaneous protein, or a biomolecule that is an agonist or antagonist with respect to said polypeptide or to said protein."

The Office Action asserts that Tur discloses a cosmetic product having ATP. However, as acknowledged by the Office Action, Tur does not disclose the composition as having an ATP precursor nor does Tur disclose a biomimetic peptide.

The Office Action asserts that Degwert discloses cosmetic and dermatological formulations having carnosine (histine- β -alanyl). The Office Action asserts that it would have been obvious to one of skill in the art to combine the composition of Tur with the composition of Degwert, because it is allegedly *prima facie* obvious to combine two compositions known to be useful for the same purpose to form a third product having the very same purpose. The Office Action concludes, "One would be motivated to combine the ATP taught by Tur with carnosine as taught by Degwert et al. in the treatment of skin conditions." See Office Action, page 4.

Despite the Office Action's assertions, the purpose of the ATP taught by Tur is not the same as the purpose of carnosine as taught by Degwert. Tur teaches the use of ATP as an activator that rapidly converts the tyrosine derivatives disclosed by Tur into melanin. See column 2, lines 31–67. Degwert disclosed the use of carnosine for the prophylaxis and treatment of light-sensitive skin, preferably photodermatitis. See column 2, lines 8–37. Nowhere does Tur indicate that its disclosed ATP is for treating photodermatitis, and Degwert fails to disclose carnosine as an activator that rapidly converts tyrosine derivatives into melanin. Therefore, because the purpose of the ATP as taught by Tur is not the same as the purpose of carnosine as taught by Degwert, the rationale presented by the Office Action does not support the rejection.

For at least this reason, claim 1 would not have been rendered obvious by Tur and Degwert. Claims 2–7 and 17–22 depend from claim 1 and, thus, also would not have been rendered obvious by Tur and Degwert. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

IV. New Claims

By this Amendment, new claims 23-27 are presented. New claims 23 and 24 contain subject matter previously in claims 1 and 2, respectively. New claims 25 and 26 contain subject matter previously in claims 19 and 22, respectively. Further, new claims 23-27 depend from claim 1 and, thus, distinguish over the applied references for at least the reasons discussed above with respect to claim 1. Prompt examination and allowance of new claims 23-27 are respectfully requested.

V. Conclusion

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of the application are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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